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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3625 | |

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/650,293 | Applicant(s) CHUKWUEMEKA, CHIJIOKE |
|---|---|---|
| | Examiner Naeem Haq | Art Unit 3625 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 August 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 August 2000* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Claim Objections*

Claim 2 is objected to because of the following informalities: This claim recites "...said token form said..." Please note that the word "*form*" should be replaced with the word "*from*". Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10, 11, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 11, and 18 recite the conditional statement "...determining an amount paid by the consumer to a previous merchant if said token has been previously used..." The conditional statement renders the claims indefinite since it is unclear to the examiner what the scope of the claims is when the conditional statement is false. The applicant should consider rewriting the claim language to avoid the use of conditional statements. For examination purposes, the examiner will take the broadest reasonable interpretation of the claims and assume that the conditional statement is false since nothing in the claim language or specification precludes the conditional statement from being false. For this reason, the scope of claims 1, 11, and 18 is rendered indefinite. In addition, claim 10 is dependent

on the conditional limitation of claim 1. The scope of this claim is also indefinite since the conditional statement of claim 1 may be false as already noted above. Therefore, this claim will be analyzed only after the Applicant has clarified the scope of this claim.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-9 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (US 6,236,981 B1) in view of Colvin, Sr. (US 5,825,881) and further in view of Krsul et al (US 5,839,119).**

Referring to claims 1, 15, 11, 17, and 18, Hill teaches a method of performing at least one transaction between a consumer from a plurality of consumers and a merchant from a plurality of merchants, the plurality of consumers and the plurality of merchants utilizing computing devices connected to a network, said method comprising the following steps of: providing a token to at least one clearing server (column 2, lines 13-15; column 5, lines 62-64; column 6, lines 21-25). Hill does not teach communicating a request for an update key to said at least one clearing server. However, Colvin teaches a method of merchandising over a network wherein a client requests a new key from a master key server (column 7, lines 57-67). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was

made, to incorporate the teachings of Colvin into the method of Hill. One of ordinary skill in the art would have been motivated to do so in order to update keys that are out of sync, as taught by Colvin. Hill and Colvin do not teach that the update key is used as an authorization to modify the value of the token. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to do so in order to finalize the transaction by paying the merchant.

Referring to claim 2, Hill teaches that a consumer purchases the token from a server (column 5, lines 31-36).

Referring to claim 3, Hill teaches that the purchasing step includes the consumer providing personal information regarding a payment instrument to be used by the consumer (column 5, lines 31-36).

Referring to claim 4, Hill teaches that the financial instrument is a credit card (column 5, lines 31-36).

Referring to claim 5, Hill does not teach that the financial instrument is a cash card. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate a cash card in the method of Hill and Colvin. One of ordinary skill in the art would have been motivated to do so in order to allow the consumer to pay with any instrument the consumer desired to use.

Referring to claim 6, Hill teaches that the consumer retrieves a previously purchased token from a server (column 5, lines 31-42; column 8, lines 44-55).

Referring to claim 7, Hill teaches selecting for purchase at least one quote from a plurality of quotes of goods and services, said quotes being displayed on the computing devices utilized by the merchant (column 5, lines 62 – column 6, lines 1-42).

Referring to claim 8, Hill teaches that the consumer presents the merchant with a token (column 6, lines 3-30).

Referring to claim 9, Hill and Colvin do not teach combining into a total price prices of all said selected for purchase at least one quote, or rejecting the transaction if a value of said token is less then the said total price. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the method of Hill and Colvin. One of ordinary skill in the art would have been motivated to calculate the total price in order to allow the merchant to apply the appropriate tax on the sale of goods. In addition, one of ordinary skill in the art would have been motivated to reject the transaction if the token value was less than the total price in order to ensure that the customer paid the full price needed to consummate the transaction. Finally, Hill and Colvin do not teach communicating the total price to a clearing server. However, Hill teaches that the merchant transmits a payment token to the payment service (column 6, lines 22-25). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a total price in the method of Hill and Colvin. One of ordinary skill in the art would have been motivated to do so in order to allow the payment service to record the total value of the transaction.

Referring to claim 12, Hill teaches that the token is in memory of the computing device (column 5, lines 25-56).

Referring to claim 13, Hill teaches that the consumer establishes a data path from a computing device used by the consumer to the computing device used by the merchant (column 5, lines 6-24).

Referring to claim 14, Hill teaches that the consumer forwards a token from his/her computing device to the computing device used by the merchant (column 6, lines 3-25).

Referring to claim 16, Hill and Colvin do not teach comparing the token forwarded by the merchant to the token received by the consumer to establish whether the token was previously used. However, Krsul teaches a method of electronic payments wherein the merchant's tokens and the consumer's token are compared (column 10, lines 1-67; column 11, lines 1-67; column 12, lines 1-44). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Krsul into the method of Hill and Colvin. One of ordinary skill in the art would have been motivated to do so in order to prevent double spending by the consumer, as taught by Krsul.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-7687 for regular communications and (703)-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.

*Naeem Haq*, Patent Examiner
Art Unit 3625

January 23, 2003

WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600